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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,546	06/06/2001	Bradley W. Johnson	CC-4626-38	7552

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EXAMINER
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MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/876,546	<b>Applicant(s)</b> JOHNSON, BRADLEY W.	
	<b>Examiner</b> JAMES S. MCCLELLAN	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 51-77 is/are pending in the application.
- 4a) Of the above claim(s) 3,9,10,16,18-21,23,27,55,61 and 63-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1, 2, 4-8, 11-15, 17, 22, 24-26, 51-54, 56-60, and 62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 3, 9, 10, 16, 18-21, 23, 27, 55, 61, and 63-77 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, species, and/or subspecies, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 21, 2009. During a telephone conversation with Applicant's representative (Chris Comuntzis) on June 2, 2009, Applicant's representative clarified that the response to restriction requirement was made with traverse.

It is noted that in the May 21, 2009 response, Applicant elected Invention I (method), species A-1 (card game), subspecies B-1 (live card game), and species D-1 (jackpot based on a percentage of the total amount of the wager's placed). On page 3 of the response, Applicant identified claims 1-2, 4-14, 16-17, and 22-26 as reading on Applicant's provisional election. The Examiner disagrees with several of Applicant's identified claims. The Examiner believes that the following claims read on Applicant's provision election: 1, 2, 4-8, 11-15, 17, 22, 24-26, 51-54, 56-60, and 62. Applicant's identification of claim 16 as readable on the elected inventions/species is improper because claim 16 is directed to non-elected sub-species B-2. Claim 15, not claim 16, reads on elected sub-species B-1. Further, the Examiner notes that claims 9-10, 23, and 61 appear to be related to non-elected subspecies B-2 and are withdrawn by the Examiner. Finally, the Examiner notes that it appears that Applicant failed to identify any of claims 51-54, 56-60, and 62 as reading on Applicant's provisional election, but it is the Examiner's position that these claims also read on the elected invention, species, and sub-species.

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On pages 1 and 2 of Applicant's response, Applicant is concerned as to whether a "serious burden" truly would be imposed on the Examiner if all claims were examined. In response to Applicant's concern, the Examiner asserts that examining all claims would cause a serious burden on the Examiner because searches would have to be carried out in different recognized art areas for different statutory classes of invention (i.e., when searching the machine as opposed to merely the method). For at least this reason, examining all claims would be a serious burden on the Examiner.

On page 2, second full paragraph, Applicant notes that all of the claims had been previously examined over the course of five previous Office Actions. While the Examiner understands and appreciates Applicant's position, MPEP 811 permits the Examiner to make a restriction requirement after the first Office Action in situations that would otherwise cause a serious burden on the Office (see also 37 CFR 1.142a). While making a restriction requirement may be less likely after the first Office Action, this is an unusual case and not making a restriction requirement would cause a serious burden on the Office. Four and half years have passed since the last Office Action in 2004. Over the past four and half years, a very large volume of art has become available as potential prior art. Reviewing all of the intervening prior art for each of the claims, which could otherwise be properly restricted, would cause a serious burden on the Office. Further, the Examiner of record was not a participant in the prior prosecution.

For at least these reasons, Applicant's traversal of the Restriction Requirement is found unpersuasive. The Restriction Requirement is made FINAL. As set forth above, claims 1, 2, 4-

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8, 11-15, 17, 22, 24-26, 51-54, 56-60, and 62 read on Applicant's provisional election and claims 3, 9, 10, 16, 18-21, 23, 27, 55, 61, and 63-77 are withdrawn from further consideration.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 52 recites the limitation "the target amount" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 2, 4-8, 11, 13-15, 22, 24, 51-54, 56-60, and 62 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 2, 4-8, 11, 13-15, 22, 24, 51-54, 56-60, and 62 are rejected under 35 U.S.C. 101 because the claimed method fails to (1) tie to a particular machine or apparatus, or (2) transform a particular article to a different state or thing, as required by the CAFC's *en banc* decision of In re Bilski. More specifically, the method claims only mention a "a gaming method" in the

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preamble and fail to tie the process to a particular machine. Further, the method claims do not appear to transform a particular article to a different state or thing. It appears that the claimed features of the above listed claims may be carried out entirely by mental processes, which the CAFC has held to be non-statutory subject matter (see *In re Comiskey*).

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 11, 13-15, 17, 22, 24, 51, 52, 54, and 62 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,364,104 to Jones.

With regard to **claim 1**, Jones discloses a gaming method comprising: a. determining a plurality of gaming parameters (e.g., with main control board 40) : (i) odds of winning a primary wagering game(e.g., poker hands are awarded larger jackpots based on the odds of winning a primary wager game; see table in column 5); odds of obtaining a bonus qualifying event in the primary wagering game (e.g., poker hands are awarded larger jackpots based on the odds of winning a primary wager game; see table in column 5); odds of winning a plurality of bonus prizes (see table in column 5), the plurality of bonus prizes comprising an incrementing jackpot, the odds of winning the plurality of bonus prizes being dependent on the odds of winning the primary wagering game and the odds of obtaining the bonus game qualifying event; b. requiring at least one player to place a wager on the primary wagering game (see column 3, lines 20-23); c.

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conducting a round of the primary wagering game with the at least one player (e.g., see column 6, lines 48-49); designating the at least one player as a winner if the at least one player has a predetermined arrangement of indicia (e.g., see table in column 5) resulting from completion of the round; and e. providing an opportunity for the winner to randomly win one of the plurality of bonus prizes, and in the event the randomly chosen bonus prize is the incrementing jackpot, terminating the incrementation of the incrementing jackpot and awarding the incrementing jackpot to the winner (see column 6, lines 56-61);

[**claim 2**] wherein the incrementing jackpot is a progressive jackpot based on a percentage of a total amount of the wagers placed (see column 3, lines 52-58);

[**claim 11**] wherein the incrementing jackpot is shown on a display that can be stopped from incrementing upon winning of the incrementing jackpot (see Fig. 1; see also column 6, lines 56-61);

[**claims 13, 24**] wherein the primary wagering game comprises a card game (see column 2, lines 6-19);

[**claim 14**] wherein the card game is blackjack (e.g., "Twenty-One game"; see column 2, lines 6-16);

[**claim 15**] conducted in a live form on a card table with a human dealer and using one or more decks of conventional playing cards (e.g., see column 2, lines 20-36);

[**claim 17**] a plurality of players are electronically linked to a common jackpot display (see Fig. 5); and

[**claim 22**] placing a side wager to play bonus game (see column 3, lines 20-25).

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With regard to **claims 51, 52, 54, and 62**, Jones discloses a gaming method as set forth in detail to similar claims 1, 2, 11, 13-15, 17, 22, and 24.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4-8, 53, are 56-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of U.S. Patent No. 6,712,695 to Mothwurf.

Jones discloses each claimed feature but is silent as to an incrementing a jackpot with a minimum and maximum range.

Mothwurf teaches a table game that permits incrementing a jackpot with a minimum and maximum range (see col. 1, lines 58-63).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Jones with maximum and minimum progressive jackpot range as taught by Mothwurf to provide financial security for the casino, thereby allowing the casino to better effectively manage the size of the jackpot payouts.

10. Claims 12, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of U.S. Patent Application Publication No. 2001/0003709 to Adams.

Jones discloses each claimed feature but is silent as to a segmented prize wheel actuated by a jackpot button.



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Adams teaches the use of a segmented prize wheel actuated by a jackpot button with at least six segments (see Fig. 4, see also paragraphs 45 and 46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Jones with the bonus wheel taught by Adams because a bonus wheel provides additional excitement to the game, which increases the likelihood of continued game play.

### ***Conclusion***

11. The following prior art references are made of record as considered pertinent to applicant's disclosure but are not relied upon in this Office Action: U.S. Patent No. 5,486,005 to Neal; U.S. Patent No. 5,911,419 to Delaney; U.S. Patent No. 5,584,763 to Kelly, and U.S. Patent No. 6,179,290 to Maahs.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES S. MCCLELLAN whose telephone number is (571) 272-7167. The examiner can normally be reached on Mon-Fri (8:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES S. MCCLELLAN/  
Primary Examiner, Art Unit 3714